

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 12 of 19

REMARKS

This response is intended as a full and complete response to the final Office Action mailed August 11, 2005.

Claims 1-20 and 22-69 are pending. Claims 1, 17, 18, 19, 22, 50, 57, 59, 60, 64, 67, and 69 are amended to clarify that the profile is developed based only on the iTV interactions. The amendments contain no new matter and are fully supported by Applicants' original specification, including the claims and drawings.

Applicants traverse all of the rejections in the Office Action and respectfully request reconsideration and passage of the claims to allowance for the following reasons.

The Office Action rejected claims 22-25, 28, 32-37, 42, 45-47, 50, 52, 54, 56, 57, 59, 64 and 67-69 under 35 U.S.C. §102(a/e) as being anticipated by U.S. Patent No. 6,088,722 to Herz et al. ("Herz").

To anticipate a claim, the reference must teach every element of the claim. Herz fails to teach every element of each claim for at least the following reasons. For example, Herz fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user.

Claim 22 recites "A method of profiling iTV users, comprising: providing profiles on a plurality of iTV programs; monitoring which of said plurality of iTV programs a user accesses; and developing a profile of the user based only on the profiles of the iTV programs accessed by the user." Herz fails to disclose each element of claim 22, because Herz fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user. By contrast, Herz teaches creating a customer profile indicating the customer's preferences for predetermined characteristics of video programming before updating the customer profile based on video programs actually watched. (Herz, col. 6, lines 43-63). Thus, the customer profiles in Herz start with the customer's preferences for predetermined characteristics, while the claimed invention develops the profile of the user based only on the profiles of the iTV programs accessed by the user. Therefore, claim 22 is patentable over Herz under §102.

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 13 of 19

Claims 23-25, 28, 32-37, 42, and 45-47 depend, directly or indirectly, from claim 22 and, thus, inherit the patentable subject matter of claim 22, while adding additional elements. Therefore, claims 23-25, 28, 32-37, 42, and 45-47 are also patentable over Herz under §102.

Claim 19 recites, *inter alia*, "developing a user profile based only on the iTV interactions". For the same reasons given above with respect to claim 22, claim 19 is also patentable over Herz under §102.

Claim 50 recites "A set-top box including a memory for storing a program and a processor operative with the program to perform a method of profiling iTV users, the method comprising: monitoring which of a plurality of programs a user views; and developing a profile of the user based only on predetermined profiles of the programs viewed by the user." For the same reasons given above with respect to claim 22, claim 50 is also patentable over Herz under §102.

Claims 52, 54, and 56 depend, directly or indirectly, from claim 50 and, thus, inherit the patentable subject matter of claim 50, while adding additional elements. Therefore, claims 52, 54, and 56 are also patentable over Herz under §102.

Claim 57 recites "A computer having a memory for storing a program and a processor operative with the program to perform a method of profiling iTV users, the method comprising: monitoring which of a plurality of programs a user views; and developing a profile of the user based only on predetermined profiles of the viewed television programs." For the same reasons given above with respect to claim 22, claim 57 is also patentable over Herz under §102.

Claim 59 recites "A system for delivering selective advertising to iTV users, comprising: a database containing profile data on a plurality of iTV programs; means for monitoring which iTV programs a user accesses; means for developing a profile of the user only using profile data of the accessed iTV programs; and means for matching the user with an advertisement based on the developed user profile." For the same reasons given above with respect to claim 22, claim 59 is also patentable over Herz under §102.

Claim 64 recites "A computer readable medium storing instructions thereon to perform a method of profiling iTV users, the method comprising: monitoring which of a

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 14 of 19

plurality of fly programs having predetermined profiles a user accesses; and developing a profile of the user based only on the profiles of the accessed iTV programs." For the same reasons given above with respect to claim 22, claim 64 is also patentable over Herz under §102.

Claim 67 recites, *inter alia*, "monitoring which of said iTV programs each user visits" and "inferring a profile of each user based only on the profiles of the visited iTV programs". For the same reasons given above with respect to claim 22, claim 67 is also patentable over Herz under §102.

Claim 68 depends from claim 67 and, thus, inherits the patentable subject matter of claim 67, while adding additional elements. Therefore, claim 68 is also patentable over Herz under §102.

Claim 69 recites, *inter alia*, "a profiler for correlating content-associated profile information from a rating service with the user-requested content information and for developing a profile of the user based only on the iTV interactions". For the same reasons given above with respect to claim 22, claim 69 is also patentable over Herz under §102.

The Office Action rejected claims 1-4, 9-11, 17, 18, 30, 31 and 51 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 5,659,350 to Hendricks et al. ("Hendricks").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §2143.

The Office Action failed to establish a *prima facie* case of obviousness, because the combination of Herz and Hendricks fails to teach or suggest all the claim elements for at least the following reasons. For example, the combination fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user.

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 15 of 19

Claim 1 recites "A method for profiling iTV user, comprising: gathering user-requested content information from iTV interactions; correlating content-associated profile information from a rating service with the user-requested content information; and developing a profile of a user based on developing a profile of a user based only on the iTV interactions." Herz fails to disclose each element of claim 1, because Herz fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user. By contrast, Herz teaches creating a customer profile indicating the customer's preferences for predetermined characteristics of video programming before updating the customer profile based on video programs actually watched. (Herz, col. 6, lines 43-63). Thus, the customer profiles in Herz start with the customer's preferences for predetermined characteristics, while the claimed invention develops the profile of the user based only on the profiles of the iTV programs accessed by the user. Furthermore, Hendricks fails to bridge the substantial gap between the Herz reference and Applicants' invention. In particular, Hendricks fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user. Therefore, claim 1 is patentable over the combination of Herz and Hendricks under §103.

Claims 2-4 and 9-11 depend, directly or indirectly, from claim 1 and, thus, inherit the patentable subject matter of claim 1, while adding additional elements. Therefore, claims 2-4 and 9-11 are also patentable over the combination of Herz and Hendricks under §103.

Claim 17 recites, *inter alia*, "developing a profile of a user based only on the iTV interactions". For the same reasons given above with respect to claim 1, claim 17 is also patentable over the combination of Herz and Hendricks under §103.

Claim 18 recites, *inter alia*, "developing a profile of a user based only on the iTV interactions". For the same reasons given above with respect to claim 1, claim 18 is also patentable over the combination of Herz and Hendricks under §103.

Claims 30 and 31 depend, directly or indirectly, from claim 22 and, thus, inherit the patentable subject matter of claim 22, while adding additional elements. Therefore, claims 30 and 31 are also patentable over Herz under §102. Furthermore, because Hendricks also fails to teach developing a profile of a user based only on the profiles of

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 16 of 19

the iTV programs accessed by the user, claims 30 and 31 are also patentable over the combination of Herz and Hendricks under §103.

Claim 51 depends, directly or indirectly, from claim 50 and, thus inherits the patentable subject matter of claim 50, while adding additional elements. Therefore, claim 51 is also patentable over Herz under §102. Furthermore, because Hendricks also fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claim 51 is also patentable over the combination of Herz and Hendricks under §103.

The Office Action rejected claims 5-8 under 35 U.S.C. §103(a) as being unpatentable over Herz and Hendricks in view of U.S. Patent No. 5,223,924 to Strubbe ("Strubbe").

Claims 5-8 depend, directly or indirectly, from claim 1 and, thus inherits the patentable subject matter of claim 1, while adding additional elements. Therefore, claims 5-8 are also patentable over Herz under §102. Furthermore, because Strubbe fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claim 51 is also patentable over the combination of Herz and Strubbe under §103.

The Office Action rejected claims 12-16 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 5,848,396 to Gerace ("Gerace").

Claims 12-16 depend, directly or indirectly, from claim 1 and, thus inherits the patentable subject matter of claim 1, while adding additional elements. Therefore, claims 12-16 are also patentable over Herz under §102. Furthermore, because Gerace fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claim 51 is also patentable over the combination of Herz and Gerace under §103.

The Office Action rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of Hendricks.

Claim 19 recites, *inter alia*, "developing a user profile based only on the iTV interactions". For the same reasons given above with respect to claim 22, claim 19 is also patentable over Herz under §102. Furthermore, because Hendricks fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 17 of 19

by the user, claim 19 is also patentable over the combination of Herz and Hendricks under §103.

The Office Action rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over Herz and Hendricks in view of Strubbe.

Claim 20 depends from claim 19 and, thus inherits the patentable subject matter of claim 19, while adding additional elements. Therefore, claim 20 is patentable over Herz and Hendricks under §103. Furthermore, because Strubbe fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claim 20 is also patentable over the combination of Herz, Hendricks, and Strubbe under §103.

The Office Action rejected claims 26, 27, 29, 41, 43, 44, 49, 53, 55, 58, 60-62, 65, and 66 under 35 U.S.C. §103(a) as being unpatentable over Herz.

Claims 26, 27, 29, 41, 43, 44, 49 depend from claim 22 and, thus inherit the patentable subject matter of claim 22, while adding additional elements. Therefore, claims 26, 27, 29, 41, 43, 44, and 49 are patentable over Herz under §102 and §103.

Claims 53 and 55 depend from claim 50 and, thus inherit the patentable subject matter of claim 50, while adding additional elements. Therefore, claims 53 and 55 are patentable over Herz under §102 and §103.

Claim 58 depends from claim 57 and, thus, inherits the patentable subject matter of claim 57, while adding additional elements. Therefore, claim 58 is also patentable over Herz under §102 and §103.

Claim 60 recites "developing a profile of the user based only on predetermined profile data of iTV programs accessed by the user." For the same reasons given above with respect to claim 22, claim 60 is patentable over Herz under §102 and §103.

Claims 61 and 62 depend from claim 60 and, thus inherit the patentable subject matter of claim 60, while adding additional elements. Therefore, claims 61 and 62 are patentable over Herz under §102 and §103.

Claims 65 and 66 depend from claim 64 and, thus inherit the patentable subject matter of claim 64, while adding additional elements. Therefore, claims 65 and 66 are patentable over Herz under §102 and §103.

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 18 of 19

The Office Action rejected claims 38-40 and 48 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 6,005,597 to Barrett et al. ("Barrett").

Claims 38-40 and 48 depend from claim 22 and, thus inherit the patentable subject matter of claim 22, while adding additional elements. Therefore, claims 38-40 and 48 are patentable over Herz under §102 and §103. Furthermore, because Barrett fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claims 38-40 and 48 are also patentable over the combination of Herz and Barrett under §103.

The Office Action rejected claim 63 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 6,708,335 to Ozer et al. ("Ozer").

Claim 63 depends from claim 60 and, thus inherits the patentable subject matter of claim 60, while adding additional elements. Therefore, claim 63 is patentable over Herz under §102 and §103. Furthermore, because Ozer fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claim 63 is also patentable over the combination of Herz and Ozer under §103.

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 19 of 19

CONCLUSION

Applicants believe that the claims are in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Lea A. Nicholson or Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 11/14/05


Lea A. Nicholson
Lea A. Nicholson
Reg. No. 48,346
(732) 530-9404

Patterson & Sheridan, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702

401634_1